

REMARKS

Applicants have carefully considered the July 6, 2006 Office Action, and the amendments above together with the comments that follow are presented in a bona fide effort to address all issues raised in that Action and thereby place this case in condition for allowance. Claims 19-25 are pending. Claims 23-25 have been withdrawn from consideration pursuant to the previous restriction requirement.

In response to the Office Action dated July 6, 2006, claim 19 has been amended and new dependent claim 26 has been added. Care has been exercised to avoid the introduction of new matter. Adequate descriptive support for the present Amendment should be apparent throughout the originally filed disclosure as, for example, the depicted embodiments and related discussion thereof in the written description of the specification. Applicants submit that the present Amendment does not generate any new matter issue. Entry of the present Amendment is respectfully solicited. It is believed that this response places this case in condition for allowance. Hence, prompt favorable reconsideration of this case is solicited.

Independent claim 19 and dependent claim 21 were rejected under 35 U.S.C. § 102(a) as unpatentable over Hofschien et al. (WO 99/00962, hereinafter "Hofschien"). Applicants respectfully traverse.

The factual determination of lack of novelty under 35 U.S.C. § 102 requires the identical disclosure in a single reference of each element of a claimed invention, such that the identically claimed invention is placed into the possession of one having ordinary skill in the art. *Helifix Ltd. v. Blok-Lok, Ltd.*, 208 F.3d 1339, 54 USPQ2d 1299 (Fed. Cir. 2000); *Electro Medical Systems S.A. v. Cooper Life Sciences, Inc.*, 34 F.3d 1048, 32 USPQ2d 1017 (Fed. Cir. 1994). Moreover, in imposing the rejection under 35 U.S.C. § 102, the Examiner is required to

specifically identify wherein an applied reference is perceived to identically disclose each feature of a claimed invention. *In re Rijckaert*, 9 F.3d 1531, 28 USPQ2d 1955 (Fed. Cir. 1993); *Lindemann Maschinenfabrik GMBH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 221 USPQ 481 (Fed. Cir. 1984). That burden has not been discharged. Moreover, there are significant differences between the claimed invention and the device disclosed by Hofschien that would preclude the factual determination that Hofschien identically describes the claimed invention within the meaning of 35 U.S.C. § 102.

Hofschien fails to disclose any volume control means controlling both a volume of the replayed music and a volume of the talking voice of the telephone communication. Therefore, the above argued differences between the claimed subject matter undermines the factual determination that Hofschien discloses the portable telephone set identically corresponding to that recited in independent claim 19. Applicants, therefore, submit that the imposed rejection under 35 U.S.C. § 102 for lack of novelty as evidenced by Hofschien is not factually viable and, hence, solicit withdrawal thereof.

Moreover, newly added dependent claim 26 is free from the applied art in view of its dependency from independent claim 19. Further, the applied references fail to disclose or suggest the volume control means of the present claims, much less a volume control means that reduces the volume of the replayed music when superposing the talking voice of the telephone communication on the replayed music in the process of the music replay.

Dependent claims 20 and 22 stand rejected under 35 U.S.C. § 103 as unpatentable over Hofschien in view of in view of Chin (US 5,661,788). Applicants respectfully traverse.

Applicants incorporate herein the arguments previously advanced in traversal of the rejection of claims 19 and 21 under 35 U.S.C. § 102(a) predicated upon Hofschien. The

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secondary reference to Chin does not cure the argued deficiencies of Hofschien. Chin was relied upon by the Examiner for only disclosing selectively alerting users of preferred telephone calls, but is silent as the claimed volume control means. Thus, even if the applied references are combined as suggested by the Examiner, and Applicants do not agree that the requisite realistic motivation has been established, the claimed invention will not result. *Uniroyal, Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044, 5 USPQ2d 1434 (Fed. Cir. 1988). Accordingly, reconsideration and withdrawal of the rejection are respectfully submitted.

It is believed that all pending claims are now in condition for allowance. Applicants therefore respectfully request an early and favorable reconsideration and allowance of this application. If there are any outstanding issues which might be resolved by an interview or an Examiner's amendment, the Examiner is invited to call Applicants' representative at the telephone number shown below.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

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